

Serial No. 10/711,785

Response Dated June 6, 2007

Reply to Communication of 03/06/2007

REMARKS

Claims 1-4, 6-11, 16, 17, 19, 20, 24-30, 33 and 34 stand rejected under 35 U.S.C. 102(b) as being anticipated by Ricles.

Claims 1, 2, 7-11, 16, 17, 24-27, 29, 30 and 33 stand rejected under 35 U.S.C. 102(b) as being anticipated by Wesson et al.

Claims 5 and 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ricles et al. in view of Renfro et al.

Claims 12-15 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ricles et al. in view of Brooks (US 5,612,189) or Mills et al. (US 5,513,703).

Claims 11, 13 and 15 are objected under 37 CFR 1.75(c).

Applicant respectfully amends independent claims 1, 16, and 29 and dependent claims 2-11, 16-20, 29, and 31-34. Claims 12-15 and 21-28 are canceled. Claims 35-42 are withdrawn.

Independent apparatus claims 1 and 16 are each amended to identify that the tool includes a pressurized chamber carrying a treatment fluid. Independent method claim 29 has been amended to identify that the tool includes a pressurized chamber carrying a treatment fluid and that the treatment fluid is released into the wellbore.

The Examiner has rejected the prior dependent claims addressing the application of the treatment fluid aspects of the present invention, asserting that "it would have been obvious to inject a treatment fluid into a formation after a perforating operation to enhance the production of the hydrocarbon fluids as evidenced by Brooks (see figures 1-4 and column 1, line 66 through column 2 line 18) or Mills et al (see abstract)." (emphasis added). Applicant respectfully submits that both Brooks and Mills et al. fail to teach or suggest providing a tool having a pressurized chamber carrying the treatment fluid or applying a treatment fluid from a chamber carried by the tool before, during or after gun detonation, as recited in the independent claims in combination with other features.

Brooks does not teach or suggest a tool chamber carrying the treatment fluid. Brooks teaches a conduit that extends to the surface for providing the well treatment fluid. (Col. 1, lines

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73-74). Further, Brooks teaches away from utilizing a pressurized chamber carrying the treatment fluid into the wellbore, stating that "since the injection volume is controlled by surface facilities, the dimensions of the tool are restricted only to that which will house the internal components, e.g., perforating means." (Col. 2, lns. 5-8).

Mills et al. provides a methods and apparatus for perforating and treating wellbore production zones. U.S. Patent no. 5,513,703 to Mills et al. provides 46 drawing sheets and 37 columns of text describing the invention. The Examiner relies on a general reference to the Abstract of Mills et al. for support of the rejection. The Examiner does not identify where or how Mills et al. teaches Applicant's claimed structure or steps nor a motivation to combine Applicant's claimed elements. From review of the Abstract of Mills et al., Applicant can only guess that the Examiner is referring to the last sentence of the Abstract, wherein it is stated that "[w]ork strings are lowered into selected assemblies to cause tools carried thereby to sequentially detonate the shaped charges to perforate the zone opposite thereto and to selectively open or close the perforated zones by shifting a sleeve with a housing of the assembly as well as treating the perforated zones." (emphasis added). Mills et al. does not teach a pressurized chamber carrying the treating fluid, but teaches an apparatus that can be shifted to expose the created perforations for treating.

Before a claim may be rejected under section 103, the examiner must establish a *prima facie* case of obviousness. See MPEP, Section 2142. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation . . . to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP, Section 2143.

Applicant respectfully submits that the Examiner has failed to identify each element claimed in Applicant's independent claims. Further, the Examiner has failed to provide a teaching or suggestion to combine the elements asserted in the fashion suggested by the Examiner to achieve Applicant's claimed invention. Additionally, Brooks teaches away from Applicant's claimed invention.

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In *KSR Int'l Co. v. Teleflex*, No. 04-1350 (U.S. Apr. 30, 2007) the Supreme Court stated at page 14 of the slip opinion:

"Often, it will be necessary . . . to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) ("*[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness*"). (emphasis added).

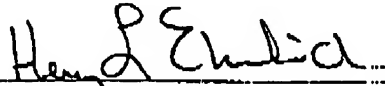
Applicant respectfully submits that the examiner has failed to establish a *prima facie* case of obviousness. Therefore, the rejections must be withdrawn.

Applicant respectfully requests that the objections and rejections be withdrawn and that a Notice of Allowance be mailed.

Respectfully submitted,
WINSTEAD PC

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DATE

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